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EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/248,436	KORN ET AL.	
	Examiner	Art Unit	
	Jefferey F. Harold	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-55 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) 31-53 is/are allowed.

6) Claim(s) 1-30, 54 and 55 is/are rejected.

7) Claim(s) ____ is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. ____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4

4) Interview Summary (PTO-413) Paper No(s). ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-4** are rejected under 35 U.S.C. 102(b) as being anticipated by Cameron (United States Patent 5,131,030).

Regarding **claim 1**, Cameron discloses a light controlled telephone ringer. In addition, Cameron discloses a photo cell (48), which reads on claimed “light sensing device”, operable to produce an inherent signal indicative of a level of ambient light; and SCR (36), which reads on claimed “controller” is operable to receive the signal and disable the telephone ringer when the signal indicates that ambient light has reached a predetermined level, as disclosed at column 4, line 41 through column 5, line 10 and exhibited in figures 1-3.

Regarding **claim 2**, Cameron discloses everything claimed as applied above (see claim 1), in addition, Cameron discloses wherein the SCR (36) is operable to disable the telephone ringer when the inherent signal indicates that the ambient light has fallen below a predetermined threshold, as disclosed at column 4, lines 56 through column 5, line 10 and exhibited in figures 1-3.

Regarding **claim 3**, Cameron discloses everything claimed as applied above (see claim 1), in addition, Cameron discloses wherein the photo cell (48) is a cadmium

sulfide light dependent resistor, which reads on claimed “taken from the group consisting of a photovoltaic cell, a photo-transistor, and a photo-resistor”, as disclosed at column 4, lines 43-47.

Regarding **claim 4**, Cameron discloses everything claimed as applied above (see claim 1), in addition, Cameron discloses wherein the light controlled telephone is a module system for insertion between a telephone set and a telephone system, as disclosed in claim 1 and exhibited in figures 1-3.

2. **Claims 6-8 and 10-11** are rejected under 35 U.S.C. 102(b) as being anticipated by as being anticipated by Kikinis (WO 97/16932).

Regarding **claim 6** Kikinis discloses a selective notification method for portable electronic devices. In addition, Kikinis discloses wherein a portable electronic device (PED) is a device such as cellular phone, which reads on claimed “telephone”, further the PED comprises an alert apparatus, which reads on claimed “ringer”, operable by the control circuitry for providing a signal to alert a user, as disclosed at page 1, lines 20-26, the alert apparatus comprising: a light sensor (13) to detect changes in light within the environment were the PED is used and providing input, which reads on claimed “first signal indicative of a level of ambient light”, to the microprocessor control circuit (45), as disclosed at page 4, lines 13-23 and exhibited in figure 2; a clock (35) operable to provide a second signal indicative of a timing condition, as disclosed a page 9, lines 4-13 and exhibited in figure 5; microprocessor (37), within microprocessor control circuit (45), operable to receive the light sensor (13) input and clock (35) input, and disables the selective notification feature of alert mechanism, which reads on claimed “ringer”,

when the predetermined time set according to clock (35) has occurred such that during the deactivation period, during nighttime hours when the user is normally asleep in a quiet room, as disclosed at page 9, lines 14-18.

Further **claim 6** is generic to a plurality of disclosed patentably distinct species comprising a light sensing device and a timing device. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Regarding **claims 7-8**, Kikinis discloses everything claimed as applied above (see claim 6), in addition claims 7-8 are rejected for the reason set forth above in the rejection of claim 6.

Regarding **claim 10**, Kikinis discloses everything claimed as applied above (see claim 6), in addition the light sensor (13) and clock (35) and control circuit (45) are integral with the PED, as exhibited in figure 5.

Regarding **claim 11**, Kikinis discloses everything claimed as applied above (see claim 6), in addition, claim 11 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 6.

Regarding **claim 13**, Kikinis discloses everything claimed as applied above (see claim 6), in addition, Kikinis discloses wherein the PED comprises both the clock (35) and the microprocessor circuit which reads on claimed "timing device is integral with the timing device, as disclosed in figures 2 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron in view of Duplane Corp v. Derring Milliken, Inc. (197 USPQ 342).

Regarding **claim 5**, Cameron discloses everything claimed as applied above (see claim 1), in addition Cameron discloses the light controlled telephone ringer as a modular system, however, Cameron fails to disclose a system integrated within the telephone. However, the examiner maintains that it was well known in the art to provide a system integrated within the telephone.

According to The Duplan Corporation v. Deering Milliken, Inc. et al. (Decided July 29, 1977), there can be no invention in merely providing means to selectively alternate between one unpatentable configuration of elements and another unpatentable configuration of old elements, where there is no new or different function. Hence, the configuration of claim 4 is unpatentable over Cameron, as disclosed above, and the

configuration of claim 5 merely integrates the apparatus of claim 4 within a telephone without providing a new or different function. Thus claim 5 is rejected for the above cited reasons as disclosed in *The Duplan Corporation v. Deering Milliken, Inc. et al.*

4. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of *Duplane Corp v. Derring Milliken, Inc.* (197 USPQ 342).

Regarding **claim 9**, Kikinis discloses everything claimed as applied above (see claim 6), in addition Kikinis discloses wherein the light sensing device, timing device and controller are integral with the telephone, however, Kikinis fails to disclose a system that is modular to be coupled between a telephone line and an input connection of the telephone. However, the examiner maintains that it was well known in the art to provide a system that is modular to be coupled between a telephone line and an input connection of the telephone.

According to *The Duplan Corporation v. Deering Milliken, Inc. et al.* (Decided July 29, 1977), there can be no invention in merely providing means to selectively alternate between one unpatentable configuration of elements and another unpatentable configuration of old elements, where there is no new or different function. Hence, the configuration of claim 10 is unpatentable over Kikinis, as disclosed above, and the configuration of claim 9 merely separates the components found in the apparatus of claim 10 and forms a module without providing a new or different function. Thus claim 9 is rejected for the above cited reasons as disclosed in *The Duplan Corporation v. Deering Milliken, Inc. et al.*

5. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of well know prior art (MPEP 2144.03).

Regarding **claim 12**, Kikinis disclose everything claimed, as applied above, (see claim 6), in addition Kikinis discloses wherein the second signal is provided to the controller from the clock to indicate a period for which the ringer is disabled however, Kikinis fails to disclose varying times on varying days. However, the examiner takes official notice of the fact that it was well know in the art to provide varying times on varying days.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis by specifically providing varying times on varying days, for the purpose of modifying the period for disabling the ringer during the week and change that period during the weekend.

6. **Claims 14-20 and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Cameron and further in view of Serby (United States Patent 4,924,499).

Regarding **claim 14**, Kikinis discloses light sensor (13), which reads on claimed "light sensing device" operable to produce a signal indicative of a change in the ambient light condition, as disclosed at page 4, lines 13-22; the microcontroller control circuit (45) receives a signal from the light sensor (13) and then sends signals to a volume control circuit, which will automatically adjust the loudness of the alert mechanism, which reads on claimed "telephone ringer", as disclosed at page 4, lines 23-33,

however, Kikinis fails to disclose a predetermined level and disabling the telephone ringer when the predetermined level is achieved. However, the examiner maintains that it was well known in the art to provide a predetermined level and disabling the telephone ringer when the predetermined level is achieved, as taught by Cameron.

In addition, Cameron discloses a photo cell (48), which reads on claimed "light sensing device", operable to produce an inherent signal indicative of a level of ambient light; and SCR (36), which reads on claimed "controller" is operable to disable the telephone ringer when the inherent signal received from the photo cell (48) indicates that the ambient light has fallen below a predetermined threshold, as disclosed at column 4, lines 41 through column 5, line 10 and exhibited in figures 1-3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis by specifically providing a predetermined level and disabling the telephone ringer when the predetermined level is achieved, as taught by Cameron, for the purpose of disabling the telephone ringer at night so an individual will not be awoken by a telephone ringing.

Hence as disclosed above Kikinis and Cameron, the combination, provides an apparatus for disabling a telephone ringer using a light sensing device to determine when the light condition has met a predetermined level, then sending a signal to the controller to disable the telephone ringer, however, the combination, fails to disclose a recording device operable to communicate with the controller and play back a recording to a calling party. However, the examiner maintains that it was well known in the art to

provide a recording device operable to communicate with the controller and play back a recording to a calling party, as taught by Serby.

In a similar field of endeavor Serby discloses a timer control for a telephone. In addition, Serby discloses when the telephone ringer is turned off, which reads on claimed "disable telephone ringer" the apparatus when used in conjunction with a phone answering machine, the telephone will not ring and the answering machine will answer, which reads on "play back a recording to a calling party", as disclosed at column 1, line 53 through column 2, line 7.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing a recording device operable to communicate with the controller and play back a recording to a calling party, as taught by Serby, for the purpose of allowing the answering machine to answer the telephone call without waking a sleeping person.

Regarding **claim 15**, Kikinis, Cameron and Serby disclose everything claimed as applied above (see claim 14), in addition the combination provides a controller (as disclosed in Kikinis) operable to vary the alert mechanism, which reads on claimed "telephone ringer", based on sensed light conditions. As modified, Kikinis and Cameron disclose a photo cell that disables and enables the telephone ringer via the controller when the sensed light level fall below a predetermined level, as disclosed at column 4, lines 41 through column 5, line 10 and exhibited in figures 1-3. Further, Kikinis, Cameron and Serby, as modified, provides for when the telephone ringer is disabled or

enabled, via the sensed light conditions, the answering machine will be enabled or disabled by enabling or disabling the telephone ringer.

Regarding **claim 16**, Kikinis, Cameron and Serby disclose everything claimed as applied above (see claim 14), in addition, it is inherent that an answering machine will retain a message from the calling party.

Regarding **claim 17**, Kikinis, Cameron and Serby disclose everything claimed as applied above (see claim 14), in addition claim 17 is interpreted and thus rejected for the reason set forth above in the rejection of claims 14 and 15.

Regarding **claim 18**, Kikinis, Cameron and Serby disclose everything claimed as applied above (see claim 14), in addition Cameron discloses wherein the photo cell (48) is a cadmium sulfide light dependent resistor, which reads on claimed "taken from the group consisting of a photovoltaic cell, a photo-transistor, and a photo-resistor", as disclosed at column 4, lines 43-47.

Regarding **claims 19 and 20**, Kikinis, Cameron and Serby disclose everything claimed as applied above (see claim 14), in addition the combination as disclosed may be either modular or integral as disclosed by as modified elements into Kikinis or Serby (column 1, line 67 through column 2, line 7), further claims 19 and 20 are interpreted and thus rejected for the reasons set forth above in the rejection of claims 5 and 9.

Regarding **claim 54**, Kikinis, Cameron and Serby discloses everything claimed, in addition claim 54 is interpreted and thus rejected for the reason set forth above in the rejection of claims 14-20.

7. **Claims 21-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Serby.

Regarding **claim 21**, Kikinis discloses a light sensing device, a timing device and a controller to receive a signal from either device and disable the telephone ringer (i.e., notification feature of the alert mechanism) when the second signal (i.e., signal from the timing device) indicates that a predetermined timing condition is achieved, as disclosed above in the rejection of claim 6. However, Kikinis fails to disclose a recording device operable to communicate with the controller and play back a recording to a calling party. However, the examiner maintains that it was well known in the art to provide a recording device operable to communicate with the controller and play back a recording to a calling party, as taught by Serby.

In a similar field of endeavor Serby discloses a timer control for a telephone. In addition, Serby discloses when the telephone ringer is turned off, which reads on claimed "disable telephone ringer" the apparatus when used in conjunction with a phone answering machine, the telephone will not ring and the answering machine will answer, which reads on "play back a recording to a calling party", as disclosed at column 1, line 53 through column 2, line 7.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis by specifically providing a recording device operable to communicate with the controller and play back a recording to a calling party, as taught by Serby, for the purpose of allowing the answering machine to answer the telephone call without waking a sleeping person.

Further **claim 21** is generic to a plurality of disclosed patentably distinct species comprising a light sensing device and a timing device. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Regarding **claim 22**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), Kikinis and Serby, the combination as modified, discloses a controller responsive to the second signal that indicates that the predetermined timing condition has been satisfied and a recording device that may play back the recording to the calling party operable to communicate with the controller and play back a recording to a calling party, however the as modified combination fails to disclose enabling and disabling a recording device. However, the examiner maintains that it was well known in the art to provide enabling and disabling a recording device, as taught by Serby.

In a similar field of endeavor Serby discloses a timer control for a telephone. In addition, Serby discloses circuitry controlled by programmable timers, when used with a phone answering machine, to turn the telephone ringer circuit and the answering machine on and off and at preprogrammed times or for a preprogrammed interval,

which reads on claimed "enabling and disabling a recording device", as disclosed at column 3, lines 32-61 and claim 3.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing enabling and disabling a recording device, as taught by Serby, for the purpose of allowing the answering machine to answer the telephone call without waking a sleeping person.

Regarding **claim 23**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), in addition, it is inherent that an answering machine will retain a message from the calling party.

Regarding **claims 24 and 25**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), in addition they are interpreted and thus rejected for the reasons set forth above in the rejection of claim 21.

Regarding **claims 26, 27 and 30**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), in addition Kikinis discloses a light sensing device, a timing device and a controller that are integrated with the PED, as disclosed in figure 5. Further claim 26, 27 and 30 are interpreted and thus rejected for the reasons set forth above in the rejection of claims 5 and 9.

Regarding **claim 28**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), in addition Kikinis discloses wherein the clock (35), which reads on claimed "timing device", is operable to provide a signal, which reads on claimed "second signal", to the controller to indicate that the alert mechanism, which reads on

claimed "telephone ringer" is to be sequentially disabled and enabled at periodic pre-set-times, as disclosed at page 9, lines 4-18.

8. **Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Serby and further in well know prior art (MPEP 2144.03).

Regarding **claim 30**, Kikinis and Serby disclose everything claimed as applied above (see claim 21), in addition claim 30 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 12.

9. **Claim 55** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron, in view of Kikinis, in view of Serby and further in well know prior art (MPEP 2144.03).

Regarding **claim 55**, Cameron, Kikinis and Serby, the combination, discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a first signal indicative of a level of ambient light, a timing device operable to produce a second signal indicative of a timing condition, a recording device operable to play back a recording to a calling party, a controller communicating with the light sensing device, the timing device and the recording device, the controller being operable to receive: the first signal and to disable the telephone ringer, or the second signal and to disable the phone ringer, or the second signal but refrain from disabling the telephone ringer unless and until it also receives the first signal, or the first signal but to refrain from disabling the phone ringer unless and until it also receives the second signal, as disclosed above in the rejection of claims 14-30, however, the combinations fails to disclose wherein the recording being played backed prompts the calling party to

provide indicia that the call is a priority call. However, the examiner takes official notice of the fact that it was well known in the art to provide wherein the recording being played back prompts the calling party to provide indicia that the call is a priority call.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination by specifically providing wherein the recording being played back prompts the calling party to provide indicia that the call is a priority call, for the purpose of providing the user with the capability of sorting through voice mail messages accessing the most urgent first.

Allowable Subject Matter

10. ***Claims 31-53*** are allowed.
11. The following is an examiner's statement of reasons for allowance:

Regarding **claim 31**, Cameron, Kikinis and Serby, the combination, discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a signal indicative of a level of ambient light, a recording device operable to play back a recording to a calling party, a controller communicating with the light sensing device and the recording device, the controller being operable to receive the signal and both to disable the telephone ringer and enable the recording device such that the recording device may play back the recording to the calling party, when the signal indicates that the ambient light has reached a predetermined level, however, the prior art of record fails to suggest wherein the recording being played back prompts the calling party to provide indicia that the call is a priority call, and the controller being

operable to initiate an emergency sequence when the indicia indicates that the call is a priority call.

Regarding **claim 40**, Cameron, Kikinis and Serby, the combination, discloses an apparatus for disabling a telephone ringer comprising: a light sensing device operable to produce a signal indicative of a level of ambient light, a timing device operable to produce a second signal indicative of a timing condition, a recording device operable to play back a recording to a calling party, a controller communicating with the light sensing device, the timing device and the recording device, the controller being operable to receive the both the light and timing signal and both to disable the telephone ringer and enable the recording device such that the recording device may play back the recording to the calling party, when either the light signal indicates that the ambient light has reached a predetermined level, or the timing signal indicates a predetermined timing condition has been satisfied, however, the prior art of record fails to suggest wherein the recording being played backed prompts the calling party to provide indicia that the call is a priority call, and the controller being operable to initiate an emergency sequence when the indicia indicates that the call is a priority call.

Regarding **claim 52**, Cameron, Kikinis and Serby, the combination, discloses an apparatus for disabling a telephone ringer comprising: a recording device operable to play back a recording to a calling party, a controller communicating with the recording device and operable to disable the telephone ringer, however, the prior art of record fails to suggest wherein the recording device play back instructions to the calling party prompting the calling party to provide indicia that the call is a priority call and the

controller being capable thereafter to initiate an emergency sequence and re-enable the ringer when the indicia from the calling party indicates that the call is a priority call.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JFH
September 24, 2002


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600